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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,709	10/18/2001	Andrew C. Gilbert	CF/041	8648
1473	7590	04/01/2005	EXAMINER	
FISH & NEAVE IP GROUP ROPES & GRAY LLP 1251 AVENUE OF THE AMERICAS FL C3 NEW YORK, NY 10020-1105			HEWITT II, CALVIN L	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/982,709

Applicant(s)

GILBERT ET AL.

Examiner

Calvin L Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 January 2005.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-75 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-75 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

***Status of Claims***

1. Claims 1-75 have been examined.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1-75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999).

The term "two-sided market" in the claims is used to mean "a market where a trader places one order, and, places a second order based on the execution of the first order" (Specification-page 2, lines 20-23), while the accepted meaning is "a market in which both bid and asked sides are firm, such as that which a specialist and others who make a market are required to

maintain" (BARRON'S FINANCIAL GUIDES: Dictionary of Finance and Investment Terms). The term is indefinite because the Specification does not clearly redefine the term. For example, Applicant's definition is directed to "offers", however an offer can be buy or sell-side. Therefore, using Applicant's definition, a "two-way market" can be interpreted as a trader placing one *sell* order, then placing a second *sell* order based on the execution of the first *sell* order. Which is clearly is repugnant to the definition as it is understood by one of ordinary skill (MPEP § 2173.05). When there is more than one definition for a term, it is incumbent on the Applicant to make clear which definition is relied upon.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-58, 59, 61, 62, 67, 69, 70 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Harrington et al., U.S. Patent No. 6,161,099.

As per claims 1-58, Harrington et al. teach a market trading system comprising:

- receiving a submission of a bid command (e.g. data related to a tradable item display) from a trader, generating an offer value based on the submission of a bid command from a trader, generating an offer value based on the submitted bid command, receiving a confirmation command from the trader to confirm the submission and submitting a bid and offer command in response to the confirmation command from the trader (figure 13)
- using an interactive display, displaying current bid and offer data and receiving a selection of a piece of the bid and offer data as the submission of a bid command, displaying the current bid and offer data in a market cell, spread sheet, window, spreadsheet, or webpage (figure 6; column 6, lines 37-65; column/line 9/65-10/14)
- coloring the piece of the bid and offer data, submitting a bid command when the trader selects a bid price as the piece of the bid and offer (figures 6 and 13)
- submitting a bid command when the trader selects a bid price as the piece of the bid and offer data (figure 12)

- entering the submission of the bid command via keyboard and using a mouse (figure 1)
- automatically displaying the interactive interface containing the confirmation command (figure 13)
- overriding the generated bid and offer size and price (figures 12, 13 and 15; column 6, lines 37-65; column/line 9/65-10/14)
- automatically presenting a second interface that relates to the bid and offer command (figures 12 and 13)
- receiving a submission of an offer command via a trading interface, and generating a bid value based on the offer command (figures 6, 12, 13, and 15)
- receiving a selection of an item in the interactive display that corresponds to an offer command (figures 3a, 5, 6, 12 and 13)

Regarding the newly added feature of submitting a two-sided market trading command that comprises the bid command and an offer command and wherein the offer command is based on the offer value, Harrington et al. teach receiving submission of a bid command (i.e. the trader initiating the bidding process or preparing a bid for a financial instrument) (column/line 8/65-9/11) and an offer value (price) based on said bid command (i.e. initiating the bidding process or preparing a bid for a financial instrument. Further, Harrington et al.

teach a trader revising an offer or "creating an offer command" if the original offer was insufficient (figure 12) and then submitting a two-sided market trading command (i.e. the bid and offer command).

As per claims 59, 61 and 62 Harrington et al. teach receiving a submission of a bid command (e.g. data related to a tradable item display) from a trader, generating an offer command based on the submission of a bid command from a trader, generating a two-sided market command comprising the bid and offer command, receiving a confirmation command from the trader to confirm the submission and submitting a bid and offer command in response to the confirmation command from the trader (figure 13). Recall, Webster's Ninth New Collegiate Dictionary defines "offer" as a "price named by one proposing to buy: BID". Therefore, claim 59, for example, reads on a trader submitting a bid to the system to ensure conformity with established parameters (column 10, lines 13-31), generating an offer using the spreadsheet in response to an error command (figure 12; column 10, lines 4-21) or update (column/line 10/5-11/7), confirming a bid (figure 13; column 10, lines 42-50) and then submitting the traders bid that comprises an offer (column/line 10/42-11/19).

As per claims 67, 69, 70 Harrington et al. teach a system that receives an offer from a trader (figure 11), generating a bid command based on the offer (figures 12 and 13), generating a two-sided market command comprising the bid

and offer command receiving confirmation and submitting the two sided command (figure 13).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 60, 63-66, 68 and 71-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harrington et al., U.S. Patent No. 6,161,099.

As per claims 63, 65, 66, 71, and 73-75, Harrington et al. teach a system for generating, overriding and displaying bids and offers (abstract; figures 1-3c and 12-15). Harrington et al. do not specifically recite requesting a confirmation of the submission of an offer command. However, Harrington et al. do teach a request for confirmation of a bid submission (figure 13). Therefore, it would have been obvious to one of ordinary skill to provide offer submitters with a confirmation to allow a submitter to verify the items for auction for which buyers are bidding.

As per claims 60, 64, 68 and 72, a "spread" is defined as the difference between the buyer's bid price and seller's offer price" (BARRON'S FINANCIAL



GUIDES: Dictionary of Finance and Investment Terms). The Harrington et al. system requires users to submit offers above a certain price (figures 12 and 13) therefore, it would have been obvious to one of ordinary skill to set the seller's offer price based on a spread, desired profit or risk.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
c/o Technology Center 2100  
Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

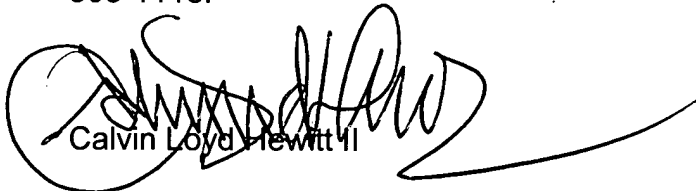
or:

Art Unit: 3621

(703) 746-5532 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,  
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application  
should be directed to the Group receptionist whose telephone number is (703)  
308-1113.



Calvin Lloyd Hewitt II

March 28, 2005